

REMARKS

The Office Action of March 17, 2009 has been received and carefully reviewed. Claims 1-5, 8-15 and 18-26 remain in the application. Reconsideration of the claims is respectfully requested.

At the outset, the Applicants would like to thank Supervisor Black for all the time and courtesies extended during the telephone conversation of April 15, 2009. During this conversation, the status of the restriction requirement and the Examiner's indication that the claims are not patentable without citation of any prior art were discussed. The Applicants indicated they would timely file the instant response, and the Supervisor indicated he would discuss the conclusion about patentability without cited references with the Examiner.

Examiner's Response to Applicants' submission of December 9, 2008

The instant Office Action indicates that it is responsive to the Applicants' communication filed on December 9, 2008. As such, Applicants assume that the communication has been entered, and thus that all claim revisions made therein have also been entered. If this is not accurate, the Applicants request that they be advised as such.

Furthermore, in the instant Office Action, the Examiner states that he "...withdraws previous action mailed on 9/09/2008 because a restriction requirement has not made [sic] by the applicants as required...." The Applicants are unsure as to what the Examiner means by this statement. Applicants interpret this statement to mean that the Examiner believes the Applicants did not appropriately respond to the previous restriction/election. However, Applicants indeed provisionally elected between the restricted claims at pages 13 and 14 of their communication filed December 9, 2008. As such, if their interpretation of the Examiner's quote above is accurate, the Applicants request that the Examiner acknowledge that the Applicants did indeed fully respond to the last restriction requirement in their communication filed December 9, 2008. If, however, the Applicants' interpretation of the

Examiner's quote above is inaccurate, the Applicants request that the Examiner clarify what he means.

Current Election/Restriction

In the Election/Restriction of the instant Office Action, the Examiner **again** restricts the claims of the application under 35 U.S.C. § 121 to one of the following two species:

- I. Claims 1, 2, 4, 11, 21, 25 and 26 which require a stationary period of the mobile vehicle; and
- II. Claims 3, 5, 8-10, 12-15, 18-20, and 22-24 which do not necessarily require a stationary period of the mobile vehicle.

Also in the Election/Restriction section of the instant Office Action, the Examiner again quotes MPEP § 806.04(c) (which Applicants assume is supposed to be MPEP § 806.05(c)II) and concludes that a restriction between combination and sub-combination is required. The Examiner states that the Applicants must elect a single species from each of the following groups:

- I. Claim 1 (including claims 2, 4 and 25) or Claim 5;
- II. Claim 1 (including claims 2, 4 and 25) or Claim 3; and
- III. Claim 21 or Claims 22-24

In response to the first of these Restriction Requirements, Applicants again provisionally elect, with traverse, Species II (Claims 3, 5, 8-10, 12-15, 18-20, and 22-24). In response to the second of these Restriction Requirements, Applicants again

provisionally elect, with traverse, in Group I - claim 5, in Group II - claim 3, and in Group III - claims 22-24. Applicants traverse these Restriction Requirements for at least the following reasons.

MPEP § 803 states that:

If the search and examination of all the claims in an application can be made without serious burden, the examiner *must* examine them on the merits, even though they include claims to independent or distinct inventions. (Emphasis added).

Furthermore, MPEP § 806.05(c) states that:

To support a requirement for restriction between combination and subcombination inventions, *both two-way distinctness and reasons for insisting on restriction are necessary*, i.e., there would be a serious search burden if restriction were not required as evidenced by separate classification, status, or field of search. (Emphasis added).

The Applicants submit that examination of all of the pending claims together would not impose a serious burden on the Examiner. The Examiner has **not** provided any showing of two-way distinctness; and further, he has provided **no** evidence and **no** analysis to show that examining these inventions/species would be a serious burden. In fact, the Examiner has again not set forth *any* separate classifications, statuses, or fields of search for the two species of the first restriction or for the claims within the various groups of the second restriction.

In fact, Applicants submit that there is **no** serious burden on the Examiner to search and examine all of the pending claims. Claims 3, 5, 8-10, 12-15, 18-20, and 22-24 had *already been searched, examined and identified as being allowed or containing allowable subject matter* (see Office Action dated July 6, 2007). The previous Examiner never issued a restriction requirement, but issued a first substantive non-final Office Action on January 17, 2007 (in which claims 3, 5, 8-10, 13, 15 and 18-20 were noted as containing allowable subject matter), to which Applicants responded on April 17, 2007, and a second substantive final

Office Action on July 6, 2007 (in which claims 3-6, 13 and 15 were allowed, and claims 8-10, 18-20, 22 and 24 were noted as containing allowable subject matter), to which Applicants responded on September 6, 2007.

The current Examiner then took over prosecution of the instant application, and without citing any references, he withdrew the indication that such claims contained allowable subject matter because “there is no incredible step...” (see Office Action of February 1, 2008). Applicants fail to see why further prosecution of these claims would constitute a serious burden on the Examiner. As such, it is submitted that the Examiner has **not** made a *prima facie* showing of a serious burden to further examine the **already-examined** pending claims without the instant restrictions.

Further, Applicants assume for purposes of this response that the Examiner has made a complete requirement for restriction in accordance with MPEP §§ 815 and 817. If the Examiner has not made a complete requirement, then Applicants respectfully request that the Examiner withdraw this restriction requirement and provide a complete restriction requirement so that Applicants can properly assess the Examiner's assertions.

Lack of U.S.C. §§ 102 and 103 Rejections

In the instant Office Action (as well as in the Office Action dated September 9, 2008), the Examiner **again** states that “generic/broadest claim 3 is not allowable because it obviously contains ideas about well-known steps of: receiving a signal at location B...in response, sending signals from location B to location A for settings...and sending an extra signal (e.g., an update signal) from location B to location A.” First, it is submitted that the Examiner has misinterpreted Applicants’ claim 3, which recites that the sending of the update flag signal (the extra signal according to the Examiner) occurs **prior** to the call center receiving the vehicle settings update signal. Applicants’ update flag signal is sent **before** the vehicle settings update signal, and thus is not an “extra signal” as set forth by the Examiner.

Second, in making the conclusion that the Examiner-misinterpreted version of Applicants' claim 3 is obvious, the Examiner **DOES NOT CITE any references** under either §§ 102 or 103. Applicants fail to see how such conclusory statements can be made without supplying ANY evidence in support of such conclusions, especially given that some deference should be given to the previous patent Examiner, who had searched and reviewed the prior art, had examined all the pending claims, and had indicated that claim 3 (among others) was allowable.

As such, it is submitted that at least this portion of the instant Action is improper, and Applicants have no way of evaluating and responding to the same. Both the MPEP and 37 C.F.R. speak to the Examiner's duty to render a clearly understandable Office Action:

MPEP § 706 Rejection of Claims [R-5]

After the application has been read and the claimed invention understood, a prior art search for the claimed invention is made. With the results of the prior art search, including any references provided by the applicant, the patent application should be reviewed and analyzed in conjunction with the state of the prior art to determine whether the claims define a useful, novel, nonobvious, and enabled invention that has been clearly described in the specification. **The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.** (emphasis added)

37 CFR 1.104. Nature of examination.

(c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) **In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.** When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as

practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis added)

As stated above, the Examiner has **not** clearly articulated any rejections for the unpatentability of the pending claims, contrary to the requirement under MPEP § 706; nor has he cited the best references at his command (he did not cite any), contrary to the requirement under 37 C.F.R. § 1.104. **Applicants request that if the Examiner is going to continue to allege that the claims are not patentable, that he set forth a clearly articulated rejection and the best references at his command, such that the Applicants can respond appropriately.**

In summary, claims 1-5, 8-15 and 18-26 remain in the application. It is submitted that, through this Response, Applicants' invention as set forth in these claims is now in a condition suitable for allowance.

Further and favorable consideration is requested. If the Examiner believes it would expedite prosecution of the above-identified application, he is invited to contact Applicants' Attorney at the below-listed telephone number.

Respectfully submitted,

DIERKER & ASSOCIATES, P.C.

/Julia Church Dierker/

Julia Church Dierker
Attorney for Applicants
Registration No. 33368
(248) 649-9900, ext. 25
juliad@troypatent.com

3331 West Big Beaver Rd., Suite 109
Troy, Michigan 48084-2813
Dated: April 17, 2009
JCD/JRK/jmo